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IN THE

Supreme Court of the United States

No. 72-468

OCTOBER TERM, 1972

SHATTERPROOF GLASS CORPORATION,
Petitioner,
vs.
GUARDIAN GLASS CO., INC., et al.,
Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

Preliminary Statement

Respondents, Guardian Glass Co., Inc., et al., respectfully ask that the Petition be denied. The subject of the Petition is not a matter of substantial public concern, nor does it raise any disputes as to established law or procedure. Rather, it is unique to the facts of this specific case.

In essence, Petitioner asks for a new trial of its patent-trade secret suit on grounds that it was denied "due pro-

cess" because of the appearance of impropriety by the District Court's receipt of Respondents' Pre-Trial Brief.

However, such Brief was submitted in compliance with the District Court's request, made to *both sides*, that *both sides* submit Pre-Trial Briefs *without exchange*. Petitioner forgot the oral request and failed to submit its Brief in compliance with the request.

Petitioner did not object to the Court's Pre-Trial request when same was made. Nor did Petitioner object to the filing by Defendants-Respondents of a Pre-Trial Brief, even when Petitioner was reminded at Trial that Respondents' Brief had been filed. Nor did Petitioner make any objection during the Post-Trial Brief periods. Nor did Petitioner object for one and one-half years after Trial, i.e., two months after decision. Ultimately, Petitioner objected—by moving for a new Trial.

The District Court refused Petitioner's Motion for a new trial. The Court of Appeals agreed. Hence, this Petition. Respondents submit that it is utterly without merit.

Thus, Petitioner's Statement of Questions and Statement of the Case omit two essential facts: (1) the District Court requested *both* sides to submit Pre-Trial Briefs without exchange, and (2) Petitioner did not timely object. Thus, to put the Petition in context in the proceedings below, Respondents restate the questions and relevant facts as follows:

RESPONDENTS' RESTATEMENT OF QUESTION PRESENTED

Is Petitioner now entitled to a new trial where Respondents submitted, but Petitioner forgot to submit, a Pre-Trial Brief in response to the District Court's oral re-

quest to *both* sides for Pre-Trial Briefs *without exchange,* particularly where Petitioner did not object to the Court's request, nor to Respondents' compliance therewith, until two months after decision, i.e., a year and a half after Trial?

RESTATEMENT OF THE CASE

Nature of the Case:

Shatterproof sued Guardian for patent infringement and alleged misappropriation of trade secrets. After a lengthy Trial, oral arguments, and copious post-trial briefs and proposed findings, the District Court dismissed the Complaint, finding Shatterproof's patent invalid, finding no trade secrets, finding no improper conduct by Guardian, and finding laches due to an unexcused nine-year delay of Plaintiff in bringing its suit. The Court of Appeals for the Sixth Circuit's affirming opinion was recently reported at 174 USPQ 374.

Background of this Litigation:

Shatterproof and Guardian are both long established manufacturers of replacement automobile windshields, which are duplicates of and are sold to glaziers, i.e., repair shops, to replace broken, original windshields. Starting in 1955, with the help of Ford Motor Company who was Guardian's glass supplier, Guardian began construction of a large, new factory, to manufacture replacement duplicates of the then recently adopted curved style windshields. This new factory went into production at about the beginning of 1957 and has been in production ever since.

Curved windshields are made by first positioning a piece of glass on a special curved mold or support and then run-

ning the mold with the glass through a long, hot furnace, where the glass becomes soft and sags down into the mold to assume the curved shape of the mold. A different curved mold is needed for each model car windshield. Thus, as many molds are needed as there are original automobile windshield models. Each year new molds are made in accordance with the automobile model changes.

Windshield bending molds are made by skilled workers called "mold makers". Thus, among the hundreds of workmen hired for its new plant, in 1956 Guardian hired two hourly-rated mold makers who had previously been employed by Shatterproof and who approached Guardian for employment. The basic mold design and technique used by Guardian was furnished to it by Ford who had earlier developed suitable molds for Ford's own manufacture of original windshields used on new Ford cars.

Although Shatterproof knew in 1956 and ever thereafter of Guardian's activity, including the employment of Shatterproof's two former mold makers, Shatterproof waited nine years before filing suit for alleged misappropriation of forty-three trade secrets by these mold makers. Shatterproof also claimed infringement of its patent relating to molds. When asked the reason for the nine-year delay, Shatterproof's president testified "no reason in particular" (A-66)[1]

At Trial, Shatterproof's officer (patentee-Jendrisak) admitted that he had gotten Shatterproof's alleged trade secret information from other companies, that the information was published and was not secret, and moreover was not maintained in secrecy by Shatterproof itself. In short, he admitted that there were no trade secrets. Further, the evidence demonstrated that such information as Guardian

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[1]Page notations preceded by the letter "A" refer to the Appendix in the Petition for a Writ of Certiorari.

used in constructing its new factory came either from Ford or from Guardian's own extensive background in the field. Thus, the District Court dismissed the trade secret count. Dismissal of this count was not appealed by Shatterproof.

As to the patent infringement claim, the District Court found the patent claims for the mold to be invalid because the subject matter thereof was both old and "obvious". Additionally, a second patent claim (i.e., a claim relating to a clamp for holding the glass edge down on the mold) was held not infringed.

Shatterproof appealed only from the holding of invalidity of that part of the patent relating to the mold construction. The Court of Appeals affirmed.

Further, the District Court dismissed the Complaint for laches, due to the nine-year unexplained delay in bringing suit. This was also appealed and affirmed.

Having completely lost on the merits, Shatterproof now pursues its contended denial of due process. This contention is based upon the "appearance" of the District Court's acceptance of Respondents' Brief which was filed in compliance with the District Court's request.

The District Court's Request for Pre-Trial Briefs Without Exchange:

Respondents' opposition to the Petition is based upon the following facts:

At the Pre-Trial Conference held in chambers on December 11, 1967, the District Court orally requested counsel for *both* sides to provide it with a Pre-Trial Brief *without exchange,* pursuant to its usual practice. Neither side objected.

No transcript was made of this oral request. But Guardian's counsel, Mr. Grauer, recorded the request in the written notes that he made during the Pre-Trial Conference, as follows:

> "Wants Pre-Trial Brief 30 days before Trial. No exchange." (see copy of Mr. Grauer's contemporaneous Pre-Trial notes in attached Appendix, pages B 7-9, particularly near bottom of B 8).[2]

The parties have stipulated to the authenticity of Mr. Grauer's contemporaneous conference notes (B 3, bottom of page, and B 4, top of page).

Guardian's attorneys remembered the request, having written it down, and consequently furnished the Court with a Pre-Trial Brief shortly before Trial. The Brief merely set forth the defenses, which were also previously noticed in detail to Shatterproof and were also recorded in the joint Pre-Trial Statement (A 26-27).

Shatterproof's attorney took no notes during the conference. He does not affirmatively deny that the Court requested Pre-Trial Briefs without exchange, only that he does not recollect the Court's request (B 4, top). He failed to furnish a Pre-Trial Brief.

When reminded of the Pre-Trial Brief during Trial, Shatterproof's counsel's *only* comment on this subject was as follows:

> "Mr. McCoy: Then I have another matter that I was not aware of really until I read the transcript really over the weekend; that I had been unaware of the fact that Mr. Cantor had provided you with a Trial Brief. I am told that it is customary in this jurisdiction to have a Trial Brief.

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[2]Page notations preceded by the letter "B" refer to the Appendix in this Brief.

The Court: A Trial Brief, yes.
Mr. McCoy: I just was not aware of that fact."
(Trial transcript, p. 546, September 16, 1969).

No objection was made. Nothing further was said about Pre-Trial Briefs, by Shatterproof, either at Trial or upon receipt of a copy of Guardian's Brief a few days later.[3] For the next six months after Trial, each side provided the Court with a number of voluminous Post-Trial Briefs, proposed findings, written comments, etc., etc. Nothing was said about the Pre-Trial Briefs.

About sixteen months after Trial, the District Court handed down its opinion (A 31). Two months later, one and one-half years after Trial, more than three years after the Court made its request for Pre-Trial Briefs, Shatterproof moved for a new trial, contending that it did not recall the Court's request for Pre-Trial Briefs (B 4). As to the request for Briefs, the Court stated (B 1):

> "I will state for the record, however, for whatever it may be worth, that my custom of recent years has been to request the parties to file Pre-Trial Briefs at least 30 days prior to Trial without exchanging. If the parties agree, that is the order, with the further proviso that they will be exchanged after Trial if the parties wish. Unfortunately, there was no transcript kept of the Pre-Trial proceedings, and hence, I can't rely on anything other than my normal practice in that respect. However, I will let the record stand at that."
>
> "If the parties don't agree to that, I don't consider the Pre-Trial Briefs."

During the Hearing on Motion for a New Trial, the parties stipulated to Attorney Grauer's contemporaneous

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[3]Shatterproof has never objected to the contents of Guardian's Brief; its objection seems to be to the fact that the Brief was filed without exchange, rather than its contents.

notes recording the Court's request (B 3) and also Shatterproof's counsel's statement that he does not recall the request (B 4). No evidence was offered at any time to suggest that Shatterproof was prejudiced by the request for Pre-Trial Briefs without exchange, or by the fact that Guardian complied with the request, or by the fact that Shatterproof did not.

Reasons for Denying the Writ:

There is nothing here of concern to the public or in conflict with established laws or practices. The subject raised by the Petition is unique to this case. Requests for Briefs and the manner in which the Brief shall be submitted, are discretionary with the District Court.

Moreover, the objections to the District Court's request for Pre-Trial Briefs without exchange was not timely made. If it were timely made, as the District Court said (B 4):

> "If anyone had suggested the slightest objection to the furnishing of Pre-Trial Briefs as the Court thinks it suggested, it never would have been done, never."

An objection made one and one-half years after the Trial, two months after decision, and over three years after the request for the Pre-Trial Brief, is not timely.

Further, Motions for new trials are addressed to the discretion of the District Court. Since there is nothing in the record to suggest any mistake of law or of abuse of such discretion in the District Court's denial of the Motion, there is no basis for reversal. See 6A *Moore's Federal Practice,* pp. 3768-73.

Finally, we think it absurd to ask for a re-trial of a lengthy patent-trade secret case solely because Respondents submitted, but Petitioner forgot to submit a Pre-Trial

Brief as requested by the Court. We fail to see how a case of denial of due process can be made out of that incident.

CONCLUSION

Respondents submit that the Petition for Writ of Certiorari is totally without merit and ask that it be denied.

Respectfully submitted,

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October, 1972.

APPENDIX TO RESPONDENTS' BRIEF

MOTION TO AMEND AND MAKE ADDITIONAL FINDINGS OF FACT AND CONCLUSIONS OF LAW AND MOTION FOR A NEW TRIAL

TRANSCRIPT OF PROCEEDINGS

Proceedings had and taken in the above-entitled cause before the Honorable Talbot Smith, District Judge, at Detroit, Michigan, on Monday, March 15, 1971.

• • • • •

(4) The Court: Well, Mr. Merriam, you weren't here during any of the pretrials. We did not have a transcript of the pretrials.

I will state for the record, however, for whatever it may be worth, that my custom of recent years has been to request the parties to file pretrial briefs at least 30 days prior to trial without exchanging. If the parties agree, that is the order, with the further proviso that they will be exchanged after trial if the parties wish. Unfortunately, there was no transcript kept of the pretrial proceedings, and, hence, I can't rely on anything other than my personal practice in that respect. However, I will let the record stand at that.

• • • • •

The Court: If the parties don't agree to that, I don't consider the pretrial briefs.

• • • • •

(7) Mr. Cantor: Your Honor is correct. There was no transcript made at that hearing. However, my associate, Mr. Grauer, during the time of that hearing wrote copious notes as to what took place, and it's not a verbal transcript, but Mr. Grauer is here and I can call him to testify

to say these are his actual contemporaneous work notes taken at the pretrial conference of December 11, 1967. That conference was attended—and I am reading a photocopy. Perhaps I can hand the Court the photocopy.

(8) The Court: Any objection, counsel?

Mr. Merriam: No. Can we have a copy, too?

Mr. Cantor: Why don't you read this one with me? I have the original here.

Mr. Merriam: All right.

Mr. Cantor: Here. I better back up. There was a pretrial on December 11, 1967. At that pretrial Mr. Grauer acted as a secretary for us. The pretrial was attended by myself; my initials are there, by Mr. Grauer, by Bill McCoy, by Bob Russell. Mr. Russell is the man who also didn't recall, apparently. Mr. Oscar Feldman is listed as Ossie Feldman. He's an attorney for Guardian; Bernie Hertzberg who was sent out of the room by the Court and, of course, the Court was there, and as I recall the Court's Clerk was there, Miss Ogden, but she's not listed on this paper.

In the course of the pretrial conference in which we discussed the background of the case, where we're going, the discovery, and so forth, if the Court will turn to the second page of Mr. Grauer's notes, I believe there's marked by an arrow—here it is—at the very bottom, one, two, three, four, five lines up from the bottom and I'm quoting Mr. Grauer's notes, "Wants pretrial brief 30 days before trial. No exchange."

Now, we prepared our brief shortly thereafter. (9) It wasn't filed for a long time. It was revised because the trial was put off for awhile, but at that pretrial conference the Court told us what I think every practitioner in Detroit that has been before this Court knows, and that is that this Court has a policy of permitting briefs to be filed

without exchange unless one of the parties speaks to the contrary. This was the Court order.

I'm sorry that at that time I was not alert enough to present to the Court a formal order for signature. It might have obviated this problem today, but this was the order which we followed.

The Court: All right.

Mr. Merriam: Well, to that, Your Honor, I simply say that—are you through, Mr. Cantor?

Mr. Cantor: Except to say that I think this first point should be stricken as contrary to the facts.

Mr. Merriam: There was no order entered which was an effective order. There is no statement in Mr. Grauer's —is it Grauer?

Mr. Grauer: That's right.

Mr. Merriam: —in Mr. Grauer's notes that Mr. McCoy agreed, and I think under the circumstances that the —it is not pertinent to go into the testimony. It would be very bad if you have to. We have two lawyers that don't remember it, one who does—two who do. Your Honor (10) remembers that it was your practice, but there's nothing in the order. The only pretrial order—the preliminary pretrial order that I have here of April 30, 1969, which is, I believe, the first one—you didn't mention it—and I think it, therefore, has to be considered as an order—certainly not an order agreed to, and that under the situation it's immaterial what the parties recall about what happened.

May I proceed with my next point, your Honor?

The Court: You may.

Mr. Cantor: Excuse me. Before you do, would it be helpful, your Honor, if I asked Mr. Grauer to swear that these are his notes or—

Mr. Merriam: Oh, I will accept his representation, your Honor.

Mr. Cantor: Fine. That would save us the trouble.

The Court: If counsel would accept the representation without swearing him in, it's satisfactory to the Court.

Mr. Merriam: I suppose you would accept Mr. McCoy's representation that he doesn't recall it?

Mr. Cantor: Oh, I presume he doesn't recall it.

The Court: All right.

• • • • •

(41) The Court: • • • Before we get into the judgment, I am going to rule on the motions here.

You may sit down, gentlemen. I may take a few minutes.

First of all, as to the motion for a new trial, the only thing I'll add about the pretrial brief to what I have said is that there is no doubt whatever in my mind that if anyone had suggested the slightest objection to the furnishing of pretrial briefs as the Court thinks it suggested, it never would have been done, never. I don't think, counsel, that your Nickerson case really covers the situation.

Mr. Jendrisak was the inventor, was the expert witness in this case. He was on the stand for days. He explained prior inventions, as he had made, and he went through this one claim by claim. He knew exactly what he was talking about. The fact that the Court didn't give him credence in all respects doesn't alter the fact that I think under the circumstances of this case that he should have been permitted to say what he thought his invention was as a matter of delineation of outlines, if nothing else, that hold down point and the three-eighths inch slope. I don't think it's necessary to add anything to what I've already said on that. (42) We have gone over those things hour after hour. There were models here in Court and all the rest of it.

In short, I am going to deny the motion for new trial, and as to the findings, additional findings, recently—I say recent—I guess within the past year or so I wrote a patent opinion which must have covered at least 15 printed pages

in Fed. Sup., and I note that when the Court of Appeals ruled on the question, it made reference to the Court's "exhaustive" opinion. Possibly the opinion in this case was also too exhaustive. I seem to detect in their language a feeling by the Court of Appeals that maybe the Court had gotten maybe a little bit verbose. That may be true in the Shatterproof case.

At any rate, I don't think, gentlemen, it's the function of the Court to take every point raised by counsel, regardless of how important or unimportant the Court may view it, and answer it in detail. I think the findings made here adequately and properly cover the topic.

I would be reluctant to burden the record with more findings, particularly in view of the fact that I am not impressed by the fact that any are required. Maybe the opinion isn't clear. Writing a clear opinion is an art. Maybe I don't have it. I say that very sincerely, but I'll tell you one thing. It will never be clarified by adding what you have here, so I am going to deny the motion for (43) additional findings.

• • • • •

(44) Mr. McCoy: Yes, your Honor. The only objection to the judgment relates to paragraph five, and as to that paragraph, which as we read it, it's an injunction. We say that, first of all, it's unusual to put an injunction in a case, that the matter really is covered by the doctrine of res judicata. In other words, if Shatterproof brought another suit, that would be a res judicata defense and it would be dealt with in that context.

Now, as to paragraph five—

The Court: Counsel, I am going to interrupt you for just a minute there. Without saying this in a critical way, I think that your client is somewhat litigious, and it may be well in this opinion to spell in, one, two, three formal

things that might possibly in other opinions be omitted. I merely throw that out to counsel. You both may want to comment on that. If my feeling is misplaced, I'll be glad to—I have an open mind on it, but I am merely pointing (45) out to you an impression.

We get back to, I recall, the enormous difficulties we had on discovery here, how point after point was argued, debated, raised, the several pretrials we had. I would like to avoid that with respect to the judgment, is possible.

Now, I interrupted you as you were going ahead. Was there something else?

• • • • •

Shatterproof v Guardian Pretrial 12/11/67 2pm
(file Guardian's pleadings)

BX, RDG, Bill McCoy, Bob Russell, Ozzie Feldman
Barney Hertzberg (excused by Judge)

BX "It asks if we ever got that trade secret matter straightened out?"

We are not asking for any further specifications
Interrogs by us re maintaining of secrecy; that T/S were then in existence; what damage; still being used by P;
P seems to believe that D would not be in business but for two former employees of P

Defenses of laches

1. Ford Windshield of 1954 - Guardian copied Ford fixtures. Where does P stand on this prior art?
2. McKelvey & Sondrsak available for X @ trial?
3. P re-employed one of its former employees - P will use him as witness (but no longer an employee). We want to be able to talk to him w/o his feeling his is violating
4. Trial date employee agr'l

McCoy

Re Ford mold drawings. Does anticipate problem & manner of operation of same, not whether it was used.

Judge "I never heard of a glass mold that was so god-damned complicated that no one could understand how it works.

No structure

Barney Hertzberg (accused by Judge)

BK The Ct asks if we ever got that trade secret matter straightened out?

We are not asking for any further specifications

Interrogs by us re maintaining of secrecy; that T/S were then in existence; what damage; still being used by P;

P seems to believe that D would not be in business but for two former employees of P

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McCoy

Re Ford mold drawings. Does anticipate problem & manner of operation of same, not whether it was used.

Judge "I never heard of a glass mold that was so god-damned complicated that no one could understand how it worked.

No stipulation

As to Sondrisak & McKelvey - they will be here

Judge says he wants to meet him after all he heard about him.

PAGE BOUND VERTICAL

OVERSIZE PAGE
SEE NEXT FRAME
FOR REMAINDER OF PAGE

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3 Re Kapiza --
we ask for a letter that he is free to talk to us.

McCoy

~~Re our interrog -- asks for~~
Re prior art to be relied upon - we want to match up with list of trade secrets.
No conclusion as to date & notice eyet
Re Ford use -- issue of public knowledge + public access.
If we rely on any other public use - we will tell them in advance.
~~Give written notice~~
How about validation? Infringement - "our position clear" by BX

Wants to show Industrial our mold book pages
Our objection is as to relevance
→ McCoy will prepare written stipulation that he will assert no more T/S, & we will permit Industrial to see our mold book pages.
→ March 1 cut-off date for discovery unless formal motion for extension
Trial date - Tuesday June 4
Wants trial brief 30 days before trial - no exchange
List of witnesses exchanged at least 30 days prior to trial - not including rebuttal witnesses
4 days for Defense trial

~~Re our interrog — asks for~~

Re prior art to be relied upon - we want to match up with list of trade secrets.

No conclusion as to date & notice ept

Re Ford use — issue of public knowledge & public access.

If we rely on any other public use — we will tell them in advance.

~~Give written notice~~

how about holidays } Infringement — "our position clear" by BX

Wants to show Jendrisak our mold book pages

Our objection is as to relevance

→ McCoy will prepare written stipulation that he will assert no more T/S, & we will permit Jendrisak to see our mold book pages.

→ March 1 cut-off date for discovery unless formal motion for extension

Trial date — Tuesday June 4

Wants trial brief 30 days before trial — no exchange

List of witnesses exchanged at least 30 days prior to trial - not including rebuttal witnesses

2 days of defense trial

3 " " plaintiff "

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Mark all documentary evidence in advance of trial & exchange

McCoy raises privilege waiver question

Just prior to trial, trial counsel will sit with Judge & informally explain trial

DISCOVERY CUT OFF DATE - MAR 1, 1967

TRIAL DATE - JUNE 4, 1967